

Notice of Allowability

Application No.

10/773,294

Examiner

John S. Chu

Applicant(s)

MIYAGI ET AL

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 2/11/05 and 3/10/05.
2. ☒ The allowed claim(s) is/are 8.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Raul Tamayo on March 10, 2005.

The application has been amended as follows:

Claim 8, line 3 after the phrase "an acid catalyst" insert - - in a reaction system- -;

, line 4 replace "a reaction" with - - the reaction- -;

, line 6 replace "step (a)" with - - step (b)- -;

, line 7 after "resulting product" insert - -obtained in step (c)- - .

The amendment in line 3 serves to clarify that the polycondensation reaction of step (a) is done in a reaction system, which provides antecedent basis for the term "reaction system" step (b). The amendment in step (c) and step (d) clarifies which product is decomposed and which product is subject to the polycondensation product in step (d).

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance: The claimed invention is drawn prior to the Examiner's Amendment above is drawn to the following:

8. (original): A process for producing a phenol novolak resin, comprising the steps of:

- (a) subjecting a phenol to a polycondensation reaction in the presence of an acid catalyst;
- (b) removing water from a reaction system;
- (c) decomposing, in the presence of an acid catalyst, the polycondensation product obtained in the step (a); and
- (d) subjecting the resulting product to a polycondensation reaction with an aldehyde or a ketone.

The inventive step is found in steps (c) and (d) wherein a polycondensation product after reaction is decomposed by the presence of an acid catalyst and subsequently subjected to a second polycondensation reaction with an aldehyde or a ketone.

None of the cited references disclose the decomposing step prior to a second polycondensation reaction, YUASA et al (6,642,345 B2) discloses the known resultant decomposing reaction that occurs even upon consuming all of the phenol reactants when making a novolak resin. The presence of an acid catalyst and heat cause the novolak resin to form phenol and a higher molecular weight resin. YUASA et al explores and discloses methods of suppressing this reaction upon completion and consummation of the reactants. YUASA et al fails to disclose the processing step of further subjecting the novolak resin to a polycondensation reaction to give a desired final novolak resin.

Because none of the references of record disclose the claimed method as recited above, claim 8 is seen as allowable and passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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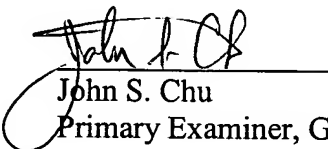
fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (571) 272-1329. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for the USPTO is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John S. Chu
Primary Examiner, Group 1700

J.Chu
March 10, 2005